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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,679	08/31/2001	Douglas J. Pearson	10017718-1	3775

7590

07/26/2005

HEWLETT-PACKARD COMPANY
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EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,679

Applicant(s)

PEARSON, DOUGLAS J.

Examiner

Truc T. Chuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This communication is responsive to Amendment, filed 05/02/05.

Claims 1-10, and 18-36 are pending in this application. Claims 1, 18, 27, and 34 are independent claims. In the Amendment, all independent claims are amended, and claims 11-17 are cancelled. This action is made final.

The text of those sections of Title 35, U.S. Code is not included in this action. It can be found in a prior office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-10 and 18-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, adding the new limitation "receive the object without scanning the object from a hard copy image" in claim 1 was not clearly described in the specification.

Other claims are also rejected because the deficiencies of their base claims.

Claim Rejections - 35 USC § 102

3. Claims 1-10, and 18-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyahara et al. (U.S. Patent No. 6,314,213 B1).

As to claim 1, Miyahara teaches a user interface configured to execute upon initiation of a printing operation from a software application, the user interface comprising an actuatable icon representing a shadow direction for an object to be rendered that when actuated actuates the rendering of a shadow having the shadow direction from the rendered object when printed onto a print media without applying the shadow to the object within the software application (setting shadow directions for objects, images, or characters using the printer/copy/fax displayed panel, or control from the computer screen, e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17), the user interface being configured to receive the object from the software application without having to scan the object from a hard copy image (the computer 1107 can be used as an image input device to transmit data to the image processing unit, e.g., col. 12 lines 25-27, col. 12 line 66-col. 13 line 5, and fig. 10; Miyahara also teaches that the invention can be applied to different devices such as host computer, printer, facsimile, etc. (e.g., col. 17 lines 52-55); therefore, the Miyahara's Image Processing System does not only get data from the scanner but also receiving data from other input sources without having to scan the object).

As to claim 2, Miyahara teaches the user interface further comprising an actuatable icon representing a shadow length for the rendered shadow that when actuated actuates the rendered shadow having the shadow length (e.g., col. 15 line 40-col. 16 line 2, and figs. 16-17).

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As to claim 3, Miyahara teaches the user interface wherein the actuatable icon is a menu item on a menu (e.g., fig. 16).

As to claim 4, Miyahara teaches the user interface wherein the menu item is a numerical expression (e.g., col. 14 lines 32-58, and figs. 13, 16-17).

As to claims 5, Miyahara teaches the user interface wherein the numerical expression is includes one or more of degrees and radians (showing angle, radius, and degree, etc. e.g., col. 14 lines 32-58, col. 15 lines 18-67, and figs. 13, 16-17).

As to claim 6, Miyahara teaches the user interface wherein the menu item is a compass point direction (e.g., col. 14 lines 32-58, col. 15 lines 18-67, and figs. 13, 16-17).

As to claim 7, Miyahara teaches the user interface wherein the rendered object having the shadow direction is rendered upon the menu (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claim 8, Miyahara teaches the user interface further comprising a print actuation icon that when actuated actuates the printing of shadowed objects having the shadow direction (e.g., figs. 13-14, 16-17).

As to claim 9, Miyahara teaches the user interface wherein a word processor software application actuates the display of the menu (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claim 10, Miyahara teaches the user interface wherein the printing operation is selected from the group consisting of printing (e.g., col. 17 lines 51-55, figs. 2-6), magnetic tape recording, photo imaging substrate recording, and magneto optical storage device writing.

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As to claims 18-25, they are method claims of system claims 1, 2, 4-6, 8, 3, and 10. Note the rejections of claims 1, 2, 4-6, 8, 3, and 10 above respectively.

As to claim 26, it is a computer program product claim of method claim 18. Note the rejection of claim 18 above.

As to claim 27, Miyahara teaches a shadow rendering system comprising:

a display device (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, and figs. 3-6, 13-14, 16-17);

a host computer in electrical communication with the display device and in response to a print function (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17), performing a demand print application program including the steps of:

serving a user interface for display as a menu item on the menu on a screen of the display device in communication with a host computer (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, and figs. 10, 13-14, & 16-17); the icon representing a selection of a shadow direction for the predetermined object (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17);

rendering a display of a predetermined object on the menu, wherein the predetermined objects is inputted without being scanned (the computer 1107 can be used as an image input device to transmit data to the image processing unit, e.g., col. 12 lines 25-27, col. 12 line 66-col. 13 line 5, and fig. 10; Miyahara also teaches that the invention can be applied to different devices such as host computer, printer, facsimile, etc. (e.g., col. 17 lines 52-55); therefore, the Miyahara's Image Processing System does not only get data from the scanner but also receiving data from other input sources without having to scan the object);

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displaying an actuatable icon as a menu item on the menu, the icon representing a selection of a shadow direction for the predetermined object (e.g. col. 15 lines 49-61, and figs. 16-17); and

upon the actuation of said menu item:

executing an application program on the host computer to calculate a rendering of a shadow having the appearance of being cast from the rendered predetermined object in the selected shadow direction (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17); and

printing the predetermined object including the calculated shadow rendering as being cast from the rendered predetermined object in the selected shadow direction (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claim 28, Miyahara teaches the system as defined in claim 27, wherein:

the shadow rendered by the application program executing on the host computer has a default length (e.g., fig. 16); and

the demand print application program further includes the steps of:

displaying a second actuatable icon on the menu as a second menu item representing a selectable shadow length for the rendered shadow (after the object has been chosen the direction in fig. 16, the object will change in fig. 17 with different directions, e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17); and

upon the actuation of said second menu item, said application program executing on the host computer further performing the step of rendering the shadow having the selected shadow length (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claims 29-33, they are similar in scope to claims 4-6, 8, and 10 above; therefore, rejected under similar rationale.

As to claims 34-36, they are computer program product claims of system claims 1, 8, and 7. Note the rejections of claims 1, 8, and 7 above respectively.

Response to Arguments

1. Applicant's arguments filed 05/02/05 have been fully considered but they are not persuasive.

Applicant has argued and Examiner disagrees with the following reasons:

a. *Miyahara does not teach the object from the software application without having to scan the object from a hard copy image.*

Miyahara clearly teaches that the computer 1107 can be used as an image input device to transmit data to the image processing unit (e.g., col. 12 lines 25-27, col. 12 line 66-col. 13 line 5, and fig. 10); Miyahara also teaches that the invention can be applied to different devices such as host computer, printer, facsimile, etc. (e.g., col. 17 lines 52-55); therefore, the Miyahara's Image Processing System does not only get (scan) data from the scanner but also receiving data from other input sources without having to scan the data object.

- b. Miyahara does not show selecting of the showdown length.*

Miyahara teaches in fig. 13 that the character can be set in different angles, which change the length of the shadow (e.g., col. 15 lines 27-48, and fig. 13).

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T. Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

07/19/05

BA HUYNH
PRIMARY EXAMINER